

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner stated that the title of the invention is not descriptive; objected to claim 10 because of informalities; rejected claims 8-10 under 35 U.S.C. § 103(a) as being unpatentable over Lumelsky (U.S. Patent No. 6,885,847, hereafter "Lumelsky") in view of Thompson et al. (U.S. Patent No. 5,812,093, hereafter "Thompson") and in further view of Yoshizawa (U.S. Patent No. 7,039,445, hereafter "Yoshizawa").

By this Amendment, Applicants amend the specification and amend claims 8-10. Claims 8-10 remain pending and under current examination.

Regarding the specification, Applicants have amended the Title of the present invention as suggested by the Examiner. Accordingly, Applicants respectfully request the Examiner to withdraw the statement pertaining to the specification.

Regarding the objection of claim 10, Applicants have amended claim 10 to correct informalities. Accordingly, Applicants respectfully request the Examiner to withdraw the objection to claim 10.

Applicants respectfully traverse the rejection of claims 8-10 under 35 U.S.C. § 103(a) as being unpatentable over Lumelsky in view of Thompson, and in further view of Yoshizawa. A *prima facie* case of obviousness has not been established.

Claim 8, as amended, recites a communication apparatus comprising, for example:

output power control means coupled to the transmission processing means and to the first and second antennas, the output power

---

<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

control means being for receiving the output of the transmission processing means and sending the output of the transmission processing means to the first antenna or the second antenna, wherein the second antenna transmits the search signal and the first antenna transmits the other transmission signals.

(Emphasis added). A *prima facie* case of obviousness has not been established, because, among other things, neither *Lumelsky*, nor *Thompson*, nor *Yoshizawa*, nor any reasonable combination thereof, teaches or suggests each and every element of claim 8.

As the Examiner acknowledges, "Lumelsky and Thompson et al. fail to disclose output power control means for making the output of said transmission processing means output from said first antenna or from said second antenna when a search signal to search for other communication devices is transmitted from said transmission processing means, in which said second antenna is used to transmit the output in a predetermined state and said first antenna is used in other cases than that, " (emphasis added) Office Action at 5. However, the Examiner asserts, "Yoshizawa discloses a control information setting section (20b) (read as output power control means; see column 4, lines 56 - 65) for making the output of transmission data processing (22) (read as transmission processing means) output from antenna (25) (read as second antenna) when a station finding message (read as search signal) to find other stations (read as search for other communication devices) is used to transmit the output in predetermined intervals (read as predetermined state; see column 5, lines 40-48)," Office Action at 6. Applicants respectfully disagree.

*Yoshizawa* discloses in column 4, lines 56-65, the following:

The control information setting section 20b [or output power control means] sets control information that is used to efficiently search for a device (subsidiary station) desired by the user according to the station finding processing executed by the radio communication apparatus 19 (station finding procedure section 28a). In this embodiment, the control information setting section 20b can set a transmission power value, antenna directivity, and station finding procedure time as control information in accordance with an instruction from the user (to be described in detail later).

Further, Yoshizawa discloses in column 5, lines 40-48, the following:

In this case, as shown in FIG. 4, the main station consecutively transmits the station finding message while changing the frequency channel at predetermined intervals in accordance with a proper frequency hopping sequence so as to cover all the frequency channels. In this case, since the main station does not obtain information about standby intervals in subsidiary stations, the main station generally transmits the station finding message for a relatively long period of time.

Accordingly, Yoshizawa is silent to the teaching of "the output power control means being for receiving the output of the transmission processing means and sending the output of the transmission processing means to the first antenna or the second antenna," as recited in claim 8. The cited references, taken either alone or in any reasonable combination, thus fail to teach or suggest a communication apparatus having the claimed output power control means. For at least this reason, Lumelsky, Thompson, and Yoshizawa fail to establish a *prima facie* case of obviousness. Accordingly, claims 8-10 are allowable.

The requisite motivation to combine the cited references is also lacking. Determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by "substantial evidence"). Further, the desire to combine

references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, the Office Action does not show, by substantial evidence, that a skilled artisan considering *Lumelsky, Thompson, and Yoshizawa*, and not having the benefit of Applicants’ disclosure, would have been motivated to combine the references in the manner alleged. The Examiner alleges in the Office Action at page 5, “it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Thompson et al. with that of Lumelsky since the practice of grounding an antenna in order to increase impedance and as a result reducing the sensitivity is well-known in the art for the purpose of reduction in transmitting and receiving power.” The Examiner further alleges in the Office Action at page 5, “it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Yashizawa with that of Lumelsky and Thompson et al. in order to provide transmission power control for periods of time when searching for other communication devices and for data communications.” However, these allegations in the Office Action are not properly supported and do not show that a skilled artisan would have combined the references as alleged.

Applicants call attention to M.P.E.P. § 2143.01, which makes clear that: “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (citations omitted). The Office Action does not show that the cited art “suggests the desirability” of the alleged combination. Moreover, the Office Action does

not provide a proper motivation from the knowledge generally available to one skilled in the art. Applicants submit that the conclusions in the Office Action pertaining to obviousness were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used in hindsight to reconstruct the prior art.

For at least these additional reasons, a *prima facie* case of obviousness has not been established with respect to claims 8-10, and the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: September 27, 2006

By:   
Michael R. Kelly  
Reg. No. 33,921